



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,722	07/15/2003	Thomas Allan Barber	PT0060 US NA	7135

23906 7590 06/30/2005

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,722

Applicant(s)

BARBER ET AL.

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,10,12,13 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,10,12,13 and 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's arguments filed 4-11-05 have been fully considered but they are not persuasive.

Rejections over GB-1,592,534 and Muller et al.(2,788,332) are withdrawn in light of applicants' amendments. However, the references are retained as art of interest for their teachings of relevant materials in the art and the use of alkanolamines in polyester polyol synthesis.

The following objection to the specification is made in light of applicants' amendments to the specification:

Specification

The amendment filed 4-11-05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants' amendments to the specification submits new matter which was not originally disclosed because the metal esterification content amount values now recited in the examples are not supported by disclosure made in the originally supported disclosure.

The assertion that these amendments are submitted to correct the previous "estimates" are not persuasive in the instant case because these values are not recited to be estimates in the originally submitted supporting disclosure nor is the variability of accuracy addressed in the originally submitted supporting disclosure.

The support for the alleged typographical omission is not seen, at least, for the above reason, and, additionally, because further factual evidence supporting this value omission beyond assertion that it was typographical is required.

Applicant is required to cancel the new matter in the reply to this Office Action. |

The following rejections are retained or newly set forth in light of applicants' amendments:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6,10,12,13, and 17-20 and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Barda (4,468,480).

Barda discloses preparations of aromatic polyester polyol compositions having acid numbers of below 3 mg/KOH/g, wherein said polyols are prepared from acid components, glycol components, and species inclusive of the non-alkoxylated aminoalcohols (i.e. triethanolamine), the functionality enhancing components of the claims, and metal esterification catalyst reading on the claims wherein the polyester polyols are prepared under the heating and pressure conditions as claimed. (see

columns 3, 4, and the examples, as well as, the entire document). The blowing effect features set forth by applicants' claims are held to be inherent features owing to the similarities of the materials defined.

Additionally, in regards to applicants' product-by-process claims it is held that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind – In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA) – and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. In re Marosi 218 USPQ 290.

Rejection is maintained because the metal materials disclosed in Barda et al.(see column 3 lines 48-60 and examples)read on the “metal esterification catalyst” as defined by the claims.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barda et al. as applied to claims 1-4,6,10,12,13, and 17-20 and 22-25above, and further in view of Volkert et al.(6,331,577).

Barda et al.'s teaching differs from applicants' claims in that the metal compound(s) of claim 25, which are now required elements, are not recited as being

used. However, Volkert et al. disclose (see column 4 lines 48 et seq.) the employment of these compounds for the purpose of catalyzing polyester polyols. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the catalysts of Volkert et al. in the processes of Barda et al. for the purpose of assisting in their disclosed polyester polyol preparations in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

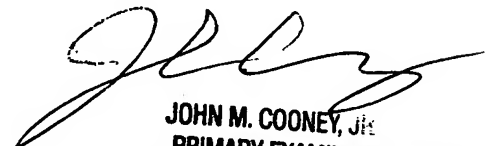
Application/Control Number: 10/619,722
Art Unit: 1711

Page 6

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700